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| 10/587,773 | 07/28/2006 | Axel Scheuer | 2004P01246WOUS | 9893 |
| 29177 7590 01/27/2009 BELF., BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690 | | | | |
| EXAMINER | | | | |
| CATTUNGAL, AJAYP | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,773

Applicant(s)

SCHEUER ET AL.

Examiner

AJAY P. CATTUNGAL

Art Unit

4173

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 07/28/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 16-24, 26-29, 31 and 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Wohlgemuth et al. (US 2003/0233537).

Re claim 16, Wohlgemuth et al. discloses a method for supporting services of an IP-based video network (Para 21 lines 6-9 and Para 31 lines 2-9), comprising: registering (register) a plurality of subscribers (Different users) of the video network with a presence server (presence and notification system), each subscriber registering (register) via an IP-capable (internet) terminal (Para 42 lines 1-3 and 8-12, Para 21 lines 6-9); logging (logged) onto the presence server (presence server) when the terminal of a first subscriber (user(1)) is activated, the plurality of subscribers including the first subscriber; storing information (maintains additional information) about a presence status (current login session) of the first subscriber (users(1)) in the presence server (presence server) as a result of the logging (logged) onto the presence server (presence server) (Para 48 lines 1-10); requesting presence information (subscribed to another user's information) about at least a portion of the plurality of subscribers by the first subscriber via the terminal; and providing presence information about the portion of subscribers (receives a notification when new information regarding other user is

available) to the first subscriber in response to the presence request (Para 22 lines 1-7).

Re claim 17, Wohlgemuth et al. discloses a method of requesting further video-network-specific information about at least a portion of the plurality of subscribers; and providing the further information to the first subscriber in response to the further request (Para 23 lines 1-12 and Para 31 lines 4-9).

Re claim 18, Wohlgemuth et al. discloses a method wherein the further information includes which of the portion of plurality of subscribers (how may users) is viewing a specific film (specific title) (Para 52 lines 1-12).

Re claim 19, Wohlgemuth et al. discloses a method wherein the further information includes for each of the portion of plurality of subscribers a service(users has voice peripheral to allow vice communications) used by the respective subscriber (Para 52 lines 1-12).

Re claim 20, Wohlgemuth et al. discloses a method wherein the further information includes for each of the portion of plurality of subscribers a file (Profile store) being seen by the respective subscriber (Para 7 and Para 35).

Re claim 21, Wohlgemuth et al. discloses a method wherein service (an invitation to become a friend or join a game session) is made available to the first subscriber based on information received about the portion of plurality of subscribers (Para 62 lines 1-3, and Para 71 lines 3-8).

Re claim 22, Wohlgemuth et al. discloses a method wherein a subscriber of another IP-based network is enabled to log on to the presence server (Para 31, lines 9-

19).

Re claim 23, Wohlgemuth et al. discloses a method wherein a subscriber of another IP-based network is enabled to log on to the presence server (Para 31, lines 9-19).

Re claim 24, Wohlgemuth et al. discloses a presence server (presence and notification system) within a communication system, comprising: a presence data of a plurality of subscribers of an IP-based (internet) video network (Para 21 lines 6-9 and Para 31 lines 2-9); and a request handler that receives by a first subscriber a request for the presence data (user's information) of at least a portion of the plurality of subscribers, the plurality of subscribers includes the first subscriber, wherein the presence data of the at least the portion of the plurality of subscribers is sent to the first subscriber in response to the request (Para 22 lines 1-7 and Para 48 lines 1-10).

Re claim 26, Wohlgemuth et al. discloses an IP-capable terminal (Para 21 lines 6-9 Internet) of a video network that is operatively connected to a TV device (Para 134 lines 1-2 Monitor or other display devices) of a first subscriber, the terminal comprising: a subscriber request (subscribes) for a presence information (information) of at least one other subscriber (users) of the video network initiated by the first subscriber, the request sent to a central device of the video network; and a subscriber presence information (information) response received in response to the request (subscribed), wherein based on the response presence information (information) is displayed on the TV device (display device) (Para 22 lines 1-7, Para 23 lines 8-12 and Para 24 lines 12-17).

Re claim 27, Wohlgemuth et al. discloses a terminal, wherein the first subscriber initiates a communication service via the terminal to the subscriber that presence information has been received (Para 46 lines 1-13).

Re claim 28, Wohlgemuth et al. discloses a terminal, wherein the communication service is an instant messaging service (Para 2 lines 3-9).

Re claim 29, Wohlgemuth et al. discloses a terminal, wherein the central device is a presence server (Para 22 lines 1-4).

Re claim 31, Wohlgemuth et al discloses a terminal, wherein the subscriber request is in accordance to an IP-based protocol (TCP/IP) (Para 3 lines 5-10).

Re claim 33, Wohlgemuth et al. discloses a terminal, wherein an application that fetches from a presence server (presence and notification system) a presence data (information) for at least one other subscriber(users) (Para 22 lines 1-7) and displays this on the TV device (Para 134 lines 1-4) of the first subscriber, the fetch in response to a prompt (subscribed) by the first subscriber of the video network via an IP-based protocol (Para 21 lines 6-9, Para 31 lines 2-9 and Para 22 lines 1-7)

Re claim 34, Wohlgemuth et al. disclose a terminal, wherein the terminal is a set-top box (STB) (Para 31 lines 1-9).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 25, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohlgemuth et al. (US 2003/0233537) in view of Beckemeyer et al. (US 2006/0031291).

Re Claim 25, Wohlgemuth et al. discloses a presence server (presence server) as set forth in claim 24 above and wherein the server can request information (any wide variety of information is maintained) of a service used by a portion of the plurality of subscribers (user) (Para 48 lines 1-10). Wohlgemuth et al does not disclose a presence server further comprising an interface to a control server that controls the video services of the video network. However Beckemeyer et al discloses a presence server (presence control server) further comprising an interface to a control server (administrative control) that controls the video services (media handling for media data exchange) of the video network (network) (Para 36, lines 2-10). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the method to control the media exchange of Beckemeyer et al. with the presence server maintaining the

information of users of Wohlgemuth et al. in order to have a presence and notification system for maintaining and communicating information.

Re claim 30, Wohlgemuth et al. discloses the claimed invention as set forth in claim 26 above. Wohlgemuth et al. does not disclose a terminal wherein the central device is a control server that controls the video network. However Beckemeyer et al. discloses a terminal wherein the central device is a control server (video control presence server) that controls the video network (handling of media data exchange) (Para 48 lines 1-10). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the method to control the media exchange of Beckemeyer et al. with the presence server maintaining the information of users of Wohlgemuth et al. in order to have a presence and notification system for maintaining and communicating information.

6. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wohlgemuth et al. (US 2003/0233537) in view of Kirn et al. (US 7,468,030).

Re claim 32, Wohlgemuth et al. discloses the claimed invention as set forth in claim 31 above. Wohlgemuth et al. does not disclose a terminal wherein IP based protocol is a SIP protocol or wherein the IP based protocol is HTTP protocol. However Kirn et al. discloses terminal wherein IP based protocol is a SIP protocol or wherein the IP based protocol is HTTP protocol (Col 2 lines 46-51). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the TCP/IP and the SIP protocol for messaging of Kirn et al. with the presence server of Wohlgemuth et al. in order to have system for real time messaging.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJAY P. CATTUNGAL whose telephone number is (571)270-7525. The examiner can normally be reached on Monday- Friday 7:30 - 5:00, Alternating Fridays OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee Lee can be reached on 571-292-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P. C./
Examiner, Art Unit 4173

/Jinhee J Lee/
Supervisory Patent Examiner, Art Unit 4173